

REMARKS

I. Claims 24, 26 -33, 35-41, 44, 45, and 47-50 stand rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Tsou et al (WO 01/85837).

Independent claims 24, and 48 recite that the composition has no more than .2 wt% of paraffinic, naphthenic or aromatic oils. It has been previously asserted that the teaching of substitution of "processing oils such as FLEXON" with polybutene oil results in a naphthenic, aromatic oil free compound. This is incorrect. Immediately preceding the quote of Tsou is the teaching that the use of the ethylene copolymer may permit "reduction" in plasticizer levels, such as STRUKTOL (STRUKTOL 40 MS, being a mixture of aliphatic, naphthenic, and aromatic oils). Thus Tsou still uses a plasticizer of the oils noted as being substantially absent in the recited composition. In all examples provided, the compositions of Tsou include STRUKTOL.

Thus, while Tsou may suggest the substituting low molecular weight polybutene for the processing oils, he fails to teach substituting, reducing, or eliminating all aliphatic, naphthenic, and aromatic oils from the composition.

As Tsou et al fails to anticipate or alternatively, render obvious, the invention as recited in the rejected claims, it is respectfully requested that this rejection be withdrawn.

II. Claims 1-5, 7, 11, 12, 14-18, 23, 24, 26-33, 35-41, 44, 45, 47-50, 51, and 52 are rejected under 35 U.S.C. § 103 as being obvious over Tsou et al as previously applied, and optionally in view of Waddell et al (US 2005/0027062: published February 3, 2005), Dias et al (US 2004/0132894: published July 8, 2004), Jones et al (US 2004/0087704: published May 6, 2004), or Waddell (US 2004/0030036: published February 12, 2004). This rejection is respectfully traversed for the following reasons.

First, all four of the newly cited, supporting references are not available as prior art in the present patent application. A review of the filing receipt shows that the present application is entitled to a priority filing date of September 17, 2002. This predates the publication dates of all of the references. It is respectfully requested that the use of these references be reconsidered and withdrawn.

These secondary references are cited for the teaching the use of polybutene oil for decreasing air impermeability, and it is held that in light of such teachings, the combination of such a polybutene oil in the composition of Tsou would have been obvious. However, as

these references are not applicable as prior art, they are not available references in the rejection to teach the recited inventive combination of a isoolefin rubber blended with both a polybutene oil and an ethylene α -olefin copolymer for improved air impermeability.

Second, independent claims 1, 24, and 48 recite that the composition has no more than .2 wt% of paraffinic, naphthenic or aromatic oils. This is not taught by Tsou. It has been previously asserted that the teaching of substitution of "processing oils such as FLEXON" with polybutene oil results in a naphthenic, aromatic oil free compound. This is incorrect. Immediately preceding the quote of Tsou is the teaching that the use of the ethylene copolymer may permit "reduction" in plasticizer levels, such as STRUKTOL (STRUKTOL 40 MS, being a mixture of aliphatic, naphthenic, and aromatic oils). Thus Tsou still teaches the use of, albeit a reduction from conventional amounts, a plasticizer of the oils noted as being substantially absent in the recited composition. In all examples provided, the compositions of Tsou include STRUKTOL. Thus, while Tsou fails to teach substituting, reducing, or eliminating aliphatic, naphthenic, and aromatic oils.

For the above reasons, Tsou fails to teach or disclose all elements of the recited invention and *prima facie* obviousness has not been established. It is respectfully requested that the rejection be withdrawn.

III. Claims 1-5, 7, 11, 12, 14-18, 23, 24, 26-33, 35-41, 44, 45, 47-50, 51, and 52 are rejected on the ground of non-statutory obviousness type double patenting as being unpatentable over claims 1-24 of US 6,875,813.

In the rejection, it is held that while the conflicting claims are not identical, they are not patentably distinct because of the species recited by Tsou over the generic claims of the present application. Thus suggesting this is the sole distinct and reason for an obviousness type double patenting rejection.

In determining obviousness-type double patenting rejection, the following guidelines are set out in MPEP 804: any obviousness-type double patenting rejection must a) identify the difference between the claims in the patent and the application claims, and b) provide reasons as to why the invention in the application claims are an obvious variant over the patent claims. Thus, *prima facie* obviousness must be established in light of the patent claims.

The difference between the present claims and claims 1-24 of Tsou are (i.e. claimed by Applicant and not claimed by Tsou): the recitation of a generic copolymer; except for

claims 14 and 20, the recitation of a polybutene oil; and the recitation of less than .2 wt% of paraffinic, naphthenic, or aromatic oil.

MPEP 804 also states that the courts have held that in considering if the application claims are an obvious variant, "the disclosure of the patent may not be used as prior art" except for use as a dictionary for patent claim terms or to find support for the claim content. Only that portion of the patent which provides support for the claims may be considered.

Thus, the difference between the claims and Tsou must be obvious by teachings or knowledge outside of the pages of Tsou. It has been previously asserted that the teaching of substitution of "processing oils such as FLEXON" with polybutene oil results in a naphthenic, aromatic oil free compound. This is incorrect. Immediately preceding the quote of Tsou is the teaching that the use of the ethylene copolymer may permit "reduction" in plasticizer levels, such as STRUKTOL (STRUKTOL 40 MS, being a mixture of aliphatic, naphthenic, and aromatic oils). Thus Tsou still uses a plasticizer of the oils noted as being substantially absent in the recited composition. In all examples provided, the compositions of Tsou include STRUKTOL. Thus, in the present rejection, there is no art provided, nor is there any suggestion of a teaching or knowledge regarding the substantial absence of paraffinic, naphthenic, or aromatic oils.

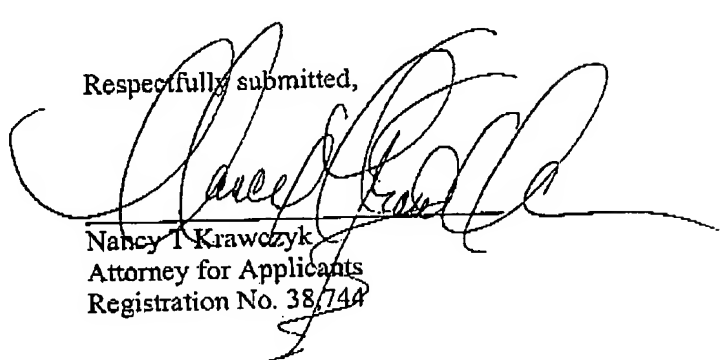
Thus, at best, the claims *might* be subject to an obviousness type double patenting rejection of claims 14 and 20 of Tsou, *IF* teachings were also provided to show the obviousness of excluding the above noted oils as recited. However, as argued above, no such teachings are provided. Thus, *prima facie* obviousness of Applicants claims over the patent claims of Tsou et al has not been established as all of the elements of Applicants claims have been set forth in the prior art.

In light of this amendment, all of the claims now pending in the subject patent application are allowable. Thus, the Examiner is respectfully requested to allow all pending claims.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated, since this should expedite the prosecution of the application for all concerned.

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